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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,412	12/23/2003	Ikuo Kawauchi	Q79133	7933

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EXAMINER

GILLIAM, BARBARA LEE

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/743,412

Applicant(s)

KAWAUCHI ET AL.

Examiner

Barbara L. Gilliam

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed July 7, 2005 has been entered and fully considered.
2. The amendment to the claims are supported by the specification and no new matter has been introduced.
3. Claims 1-11 are present of which claim 11 is new.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-11 rejected under 35 U.S.C. 102(b) as being anticipated by Miyake et al. (EP 909 657 A2).

a. The positive type photosensitive image-forming material for use with an infrared laser of Miyake et al. meet the present limitations for the infrared-sensitive lithographic printing plate. Specifically the positive type photosensitive image-forming material of Miyake et al. comprises a layer (A) which contains no less than 50% by weight of a copolymer which contains, as a copolymerization component, not less than 10 mol % of at least one of monomers (a-1) to (a-3) wherein monomer (a-1) has a sulfonamide group. Examples of monomer (a-1) include compounds represented by general formula (IV) to (VIII), all of which meet the present limitations for compound

Art Unit: 1752

(B) ([0021]-[0023]). As copolymerization components, the monomers represented by general formula (IX) to (XI), comprising an arylene group or aralkylene group, meet the present limitations for copolymer (A) ([0024]-[0028]). Other copolymerization components include acrylates, methacrylates, acrylamide and methacrylamide monomers ([0024]). Polymer compound having a phenolic hydroxyl group, such as resole-type phenol resin, novolak-type phenol resin can be contained in layer (A) ([0029]-[0031]). According to the teachings of Miyake et al. it is necessary to add at least one of the compounds which generates heat upon absorbing light, such as dyes or pigments to the layer (B) and they may be added to layer (A) as well ([0084]-[0094]). See Examples.

6. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Tomita et al. (EP 1 219 464 A2)

a. The lithographic printing plate precursor of Tomita et al. meet the present limitations for the infrared-sensitive lithographic printing plate. Specifically the lithographic printing plate precursor of Tomita et al. comprises a metal support and an image-forming layer containing a light-to-heat converting agent (abstract). The thermal positive type comprises at least a high molecular compound, such as novolak type phenolic resins, copolymers comprising monomeric units represented by formula (I), (II) or (III) and copolymers comprising monomers represented by formula (IV)-(VIII) ([0121]-[0124]; [0128]). The copolymers comprising monomeric units represented by formula (I), (II) or (III) meet the present limitations for the copolymer (A). The copolymers comprising monomeric units represented by formula (IV)-(VIII) meet the

Art Unit: 1752

present limitations for the compound (B). Other copolymer components include acrylates, methacrylates, acrylamides and methacrylamides ([0127]). The light-to-heat converting agent is preferably added in an amount from 5 to 40 wt% ([0222]-[0230]).

Response to Arguments

7. Applicant's arguments filed July 7, 2005 have been fully considered but they are not persuasive. Applicant argued that the Examiner assumed that the single copolymer disclosed by both Miyake et al. references satisfy both element (A) and element (B) of the present claims when elements (A) and (B) of the present claims are separate and different. The Examiner disagrees. Specifically in EP 909 657 A2, paragraph [0028] and EP 1 219 464 A2, paragraph [0128], it is clear that the copolymers contained in the respective layers can be used singly or in combination. When used in combination, the copolymers/monomers meet the present limitations.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the


Art Unit: 1752

advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Barbara L. Gilliam
Primary Examiner
Art Unit 1752

bg
October 3, 2005